



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/016,993	09/03/2013	Edmund S. Dubens	38336.0100	2248
11951	7590	11/19/2018	EXAMINER	
LeClairRyan 70 Linden Oaks Suite 210 Rochester, NY 14625			NIQUETTE, ROBERT R	
			ART UNIT	PAPER NUMBER
			3696	
			NOTIFICATION DATE	DELIVERY MODE
			11/19/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOinboxroc@leclairryan.com
kelly.badum@leclairryan.com
phoebe.jones@leclairryan.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDMUND S. DUBENS

Appeal 2017-005014
Application 14/016,993
Technology Center 3600

Before JEAN R. HOMERE, JOSEPH P. LENTIVECH, and
AARON W. MOORE, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–21², the only claims pending in the application on appeal. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

¹ Appellant states that the real party in interest is Interactive Driving Systems, Inc. Br. 1.

² Herein, we refer to the Specification, filed Sept. 3, 2013 (“Spec.”); the Final Office Action, mailed Jan. 8, 2016 (“Final Act.”); the Appeal Brief, filed Nov. 8, 2016 (“Br.”); and the Examiner's Answer, mailed Dec. 14, 2016 (“Ans.”). No reply brief has been filed.

STATEMENT OF THE CASE

Appellant's Invention

Appellant's invention generally relates to "facilitating a motor vehicle insurance exchange and, more particularly, for providing prospective customers with insurance underwriting rates generated by insurance providers based on a comprehensive profile or motor vehicle driver data."

Spec. ¶ 1. Claim 1, which is representative, reads as follows:

1. A method for facilitating a motor vehicle insurance exchange for motor vehicle drivers using an optimized set of data obtained from networked performance data source devices, the method comprising:

receiving, by an insurance exchange device, an insurance underwriting offer request from a client computing device associated with a motor vehicle driver and via one or more communication networks;

obtaining, by the insurance exchange device, at least historical risk event data and telematic data for the motor vehicle driver, wherein at least a portion of the historical risk event data or telematic data is obtained via another one or more communication networks from a plurality of third party server devices associated with a plurality of third parties comprising at least one government entity and at least one of a current or past insurance provider or broker for the motor vehicle driver or a leasing entity associated with the motor vehicle driver;

generating, by the insurance exchange device, an electronic performance profile for the motor vehicle driver, wherein the electronic performance profile comprises the historical risk event data and telematic data;

requesting, by the insurance exchange device, an insurance underwriting offer for the motor vehicle driver from a plurality of motor vehicle insurance providers, the requesting comprising providing the electronic performance profile comprising the historical risk event data and telematic data for

the motor vehicle driver to one or more computing devices associated with the plurality of motor vehicle insurance providers via an additional one or more communication networks;

receiving, by the insurance exchange device, an electronic insurance underwriting offer from two or more of the plurality of motor vehicle insurance providers via the additional one or more communication networks, wherein the electronic insurance underwriting offers each comprise an indication of an insurance premium for a prospective insurance policy corresponding to insurance coverage for a period of time and irrespective of any particular trip; and

sending, by the insurance exchange device, the electronic insurance underwriting offers to the client computing device associated with the motor vehicle driver in response to the received request and via the one or more communication networks.

See Br., Claims Appendix, 16–17.

*Rejection*³

Claims 1–21 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-excepted from patent eligibility under § 101. Final Act. 2–5.

PRINCIPLES OF LAW

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that

³ The rejection of claims 1–21 under 35 U.S.C. § 103 has been withdrawn. Ans. 4.

this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)).

The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* The inquiry often is whether the claims are directed to “a specific means or method” for improving technology or whether they are simply directed to an abstract end-result. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). If the claims are not directed to a patent-ineligible concept, the inquiry ends.

Otherwise, the inquiry proceeds to the second step, where the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78–79). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

CONTENTIONS AND ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments that the Examiner has erred. We disagree with Appellant’s conclusions. We adopt as our own the findings and reasons set forth by the Examiner in the Final Office Action from which this appeal is taken and the reasons set forth in the Examiner’s Answer in response to Appellant’s Appeal Brief. Final Act. 2–5; Ans. 9–13. We highlight and address specific findings and arguments for emphasis as follows.

Step 1

Appellant contends the claims are not directed to an abstract idea.

Br. 11–13. Appellant argues the claims, instead,

[A]re directed to a specific, significant, and meaningful claimed invention, rooted in computer technology, that enables generation of electronic motor vehicle insurance underwriting offers from networked insurance provider devices using electronic performance profiles for motor vehicle drivers that include an optimized set of data obtained over communication networks from various performance data source devices and differs from underwriting offers obtained using prior human-performed methods.

Br. 11–12. Appellant further argues the claims “require meaningful computer technology processing to obtain underwriting offers . . . in a manner not possible with prior human-performed methods.” Br. 11–12.

We find Appellant’s arguments unpersuasive. The Specification provides that the invention “relates to methods and devices for facilitating a motor vehicle insurance exchange.” Spec. ¶ 1; *see also* Spec., Title (“METHODS FOR FACILITATING A MOTOR VEHICLE INSURANCE EXCHANGE AND DEVICES THEREOF”); Claim 1, preamble (“A method for facilitating a motor vehicle insurance exchange for motor vehicle drivers

using an optimized set of data obtained from networked performance data source devices”). We agree with the Examiner that the claims are directed to a method for facilitating a motor vehicle insurance exchange for motor vehicle drivers, which is a fundamental economic practice; and, therefore, that the claims are directed to an abstract idea. Ans. 10–11. That the claims require the use of a computer and for data to be exchanged via one or more communication networks does not cause the claims to be directed to something other than an abstract idea. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“At best, the claims describe the automation of the fundamental economic concept of offer-based price optimization through the use of generic-computer functions.”); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (computer-implemented system for “verifying the validity of a credit card transaction[] over the Internet” was patent-ineligible).

We are not persuaded by Appellant’s argument that the claims “do not preempt any overall abstract idea or subject matter category” (Br. 13) because claims that are otherwise directed to patent-ineligible subject matter cannot be saved by arguing the absence of complete preemption. *Return Mail, Inc. v. U.S. Postal Service*, 868 F.3d 1350, 1370 (Fed. Cir. 2017). “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Id.*

Step 2

Turning to the second step of the analysis, we agree with the Examiner that the claim limitations, when viewed individually and as a whole, do not transform the claim to something significantly more than an abstract idea. Final Act. 3–4; Ans. 11–13.

Appellant contends the claims recite “significantly more” because the claims “are directed to issues rooted in computer technology for not just providing for insurance coverage online, but for significant and meaningful limitations directed towards solving issues related to obtaining sufficient data from various electronic sources in order to make more informed insurance underwriting decisions as well as interfacing electronically with multiple insurance providers in order to obtain underwriting offers.” Br. 14.

Appellant argues:

[T]he claimed technology has developed an insurance exchange system that allows insurance providers to obtain sufficient and particular data from various sources and generate an electronic performance profile in order to make more accurate underwriting decisions, thereby reducing risk, and motor vehicle drivers to interface with one web application to receive competitive and favorable insurance underwriting rates from two or more insurance providers. The claimed technology has not been utilized in this technical field before to solve long standing technical issues relating to insurance web portals and insurance data processing not possible with prior human performed methods for more effective and accurate predictive modeling.

Br. 14. Appellant further contends the claims recite “‘significantly more’ than the abstract idea asserted by the [Examiner] because they are specifically tied to computer technology.” Br. 14 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)). Appellant argues the claims are similar to the claims in *DDR*, in which claims addressing a

business challenge (retaining website visitors) that is particular to the Internet were held patent-eligible, because:

[T]he limitations relating to requesting insurance underwriting offers from motor vehicle insurance providers by generating an electronic performance profile of obtained telematic and historical risk event data and then transmitting and receiving electronic insurance underwriting offers from two or more of the motor vehicle insurance providers overcome problems relating to prior ineffective predictive modeling systems which lack this generated electronic profile and inefficient electronic transmission of predictive modeling data to facilitate web-based motor vehicle insurance purchases, which only exists in computer networks.

Br. 14.

We find Appellant’s arguments unpersuasive. Unlike the claims at issue in cases such as *DDR* (*see DDR*, 773 F.3d at 1257 (claims at issue are “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks”)) and *Enfish* (*see Enfish*, 822 F.3d at 1339 (claims at issue are “directed to a specific implementation of a solution to a problem in the software arts”)), the claims here merely address *business* challenges related to obtaining sufficient data for making informed insurance underwriting decisions and providing motor vehicle drivers seeking to purchase motor vehicle insurance underwriting offers from multiple insurance providers (*see* Br. 14). The claims address these business challenges through the use of generic, computer-related recitations that do not add meaningful limitations to steps otherwise directed to an abstract idea. *See Alice*, 134 S. Ct. at 2358 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible); *see also Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a

‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)).

Conclusion

Because Appellant’s claims are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of claims 1–21 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter in light of *Alice* and its progeny.

DECISION

We affirm the Examiner’s rejection of claims 1–21 under 35 U.S.C. § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED